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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,999	02/15/2001	Hisamitsu Shizuno	3158/FLK	4056

7590 04/03/2003

Katten Muchin Zavis Rosenman
575 Madison Avenue
New York, NY 10022

EXAMINER

BOSWELL, ALAN M

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 04/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/784,999

Applicant(s)

SHIZUNO ET AL. *MF*

Examiner

Alan M Boswell

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-15 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group II in Paper No. 5 is acknowledged.
2. Claims 1-8 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group I, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.

Claim Objections

3. Claim 8 is objected to because of the following informalities: Claim 8 requires, limitation from claim 1, however, Claim 1 is non-elected. Thus, the examiner recommends replacing the limitations of "of claim 1" (line 1 of claim 8) with the limitations of claim in its entirety. Furthermore, the limitation of "of claim 1" (line 10 of claim 8) should be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 8 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5835338 to Suzuki.

Suzuki discloses forming ceramic green sheets 10 that are composed of

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electrostrictive ceramic powder containing the barium titanate as a major component (see col. 4, lines 30-31); alternately stacking a multiplicity of internal electrode pattern 8 formed from an electrically conductive paste and as plurality of ceramic green sheets 10 to thereby produce a laminated ceramic green body (see cols. 4 and 5 lines 34-40 and 30-34 respectively); and sintering the laminated green body, wherein the sintering process is conducted at a temperature ranging 1000 to 1400°C and for a duration ranging from .5 to 20 hours (see col.4, lines 40-43, thereby producing the multilayer displacement element.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 9-11 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki in view of US Patent No. 5495386 to Kulkarni.

Regarding claims 9 and 13, Suzuki teaches the above laminations but fails to teach the ceramic green sheet has a thickness equal to smaller than 9 μm .

Kulkarni teaches the ceramic green sheet has a thickness equal to smaller than 9 μm (see col. 6, line 34-36) for the purpose of fabricating capacitors of varying capacitance depending on the application.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Suzuki with a ceramic sheet thickness of

equal to smaller than 9 μm in light of the teaching of Kulkarni for the purpose of fabricating capacitors of varying capacitance depending on the application.

Regarding claims 10-11 and 14-15, Kulkarni teaches forming the electrically conductive paste whose principal component is Ni powder (see col. 4, lines 43-58).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patent is cited to show the state of the art in the method of making multilayer displacement elements.

US Patent No. 6185087 to Park

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information. M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan M Boswell whose telephone number is (703) 305-0308. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter D. Vo can be reached on (703) 308-1789. The fax phone numbers for

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the organization where this application or proceeding is assigned are (703) 305-3579 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2572.


Other helpful telephone numbers are listed for applicant's benefit.

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April 1, 2003



A. DEXTER TUGBANG
PATENT EXAMINER